

Appl. No. 09/560,836
Reply to Office of 07/01/2005

REMARKS

Based on the following remarks, this application is deemed to be in condition for allowance and action to that end is respectfully requested.

Disposition of Claims in Office Action

Claims 49-73 are pending in the application. Claims 49-73 stand rejected.

Summary of Amendments To Claims

Applicant has canceled claims 49-73 and added new claims 74-105. The new claims, among other things, more particularly define the Applicant's invention. It is believed that no new matter has been added.

Response To Claim Rejections - 35 U.S.C. § 103(a)

The Examiner rejected claims 49-73 under 35 U.S.C. § 103(a) as follows:

- Claims 49-73 are rejected under 35 U.S.C. § 103(a) being unpatentable over U.S. Patent No. 6,053,536 to Clevenstine (Clevenstine) in view of U.S. Patent No 6,167,382 to Sparks *et al.* (Sparks) and further in view of U.S. Patent No 5,855,008 to Goldhaber (Goldhaber).
- Claims 49-73 are also rejected under 35 U.S.C. § 103(a) being unpatentable over Clevenstine in view of U.S. Patent No 5,930,810 to Farros (Farros) and further in view of Goldhaber.

Applicant disagrees with and respectfully requests reconsideration of the above rejections.

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To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on an applicant's disclosure in the specification. See In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

In one exemplary embodiment of the present invention, Applicant claims a system and method of distributing targeted content to an end user, wherein the end user has a specially formatted print medium (*e.g.*, paper with select areas for receiving user specific messages from a content provider) and a partially complete offline message from at least one of a plurality of content providers (*e.g.*, a newspaper advertisement). A user profile database is generated at a first location having information about the end user's preferences and interests. The end user accesses a second location (*e.g.*, website) that is associated with a content provider, such as an advertiser. In response to the end user's access of the second location, the content provider accesses the user profile database for the relevant user information, generates a customized, timely and complete message for the end user using information derived from the partially complete message and the end user's stored information in the user profile database. Next, the content provider forwards the customized and complete message to the end user for generation in the select areas of the specially formatted print medium. The end user is thereafter compensated (*e.g.*, with currency, points, rewards) for receiving (*e.g.*, displaying and/or printing) the

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customized message at the end user's input/output system (e.g., monitor and/or printer) in the select areas of the specially formatted print medium. The end user can redeem the compensation for items of interest, including good, services, content, etc. Thus, Applicant's invention is a marriage of two media outlets, i.e., the Internet and conventional media channels, e.g., print or broadcast, to enable a content provider-advertiser to effectively distribute targeted or customized messages directly to an end user of the system at a convenient end user location, whether, e.g., the end user's home or office, and to compensate the end user for receiving the customized messages at the end user's location.

Applicant respectfully submits that the claims are not obvious in view of the cited combination of references because there is no teaching or suggestion to modify or to combine reference teachings in the manner suggested by the Examiner.

The Examiner relies on Clevenstine as the primary reference. However, in contrast to Applicant's invention, Clevenstine is wholly directed to a method of distributing coupon envelopes to the masses via the U.S. Postal Service. Specifically, Clevenstine claims a method of creating and distributing *a prepaid mass mailer envelope having redeemable coupons printed therein*. An envelope blank is pre-printed on its inside and outside surfaces with redeemable coupon indicia within a coupon area defined by the broken line. The "coupon area" is sold to both the manufacturer and retail outlets in the same manner as advertising space. To complete the envelope mailer, the envelope blank is folded to form an envelope construction. The assembled coupon envelope mailer's outside surface is then stamped with a U.S. postage stamp or pre-printed with a prepaid first class postage permit indication for distribution via the U.S. Postal service.

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Clevenstine invention is fundamentally different from, and therefore does not teach or suggest, Applicant's claimed invention. Notably, the Clevenstine end user receives, via the U.S. Postal Service and not the Internet, a *complete* coupon mailer entirely prepared by a party different from the end user. In contrast, an end user of Applicant's claimed invention acquires a pre-generated *incomplete* message from a content provider, such as an advertiser's newspaper or broadcast advertisement, and must thereafter access a network location associated with the content provider, such as an online website(s) of the advertiser, to cause the system to dynamically generate a complete message that is customized to the end user's preferences and interests. The end user is thereafter compensated with a benefit, *e.g.*, currency, points, or rewards for printing the complete and customized message at the end user.

Clearly, Clevenstine is missing several limitations of Applicant's invention chief of which include use of the Internet to dynamically generate a customized message for an end user based on the end user having first acquired an incomplete message and the compensation of the end user with, *e.g.*, reward points, for receiving and printing the customized message at the end user. The secondary references Sparks, Goldharber and Farros fail to teach, suggest or otherwise supply the missing limitations to render Applicant's invention *as a whole*.

Sparks is directed to system for designing and producing print advertising and/or commercial display materials using standardized templates and images. The system enables a user (or "client") to (a) place a comprehensive order, at a dedicated Internet site, for standardized images and templates used for the design, assembly, production, and distribution of print advertising and/or commercial display materials; and (b) create an assembled image of the final product on the computer screen using pre-designed formats and images stored on a server in the system. Thus, Sparks concerns using the Internet to *design* print advertising and commercial

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display materials with purchased images and templates stored at a dedicated website. Sparks lacks any suggestion or motivation to use its design and production system in the manner claimed in the instant application. Sparks solves a fundamentally different and unrelated problem from that of the Applicant's invention. Notably, and in contrast to aspects of the Applicant's invention, Sparks does not teach or suggest using of the Internet to dynamically generate a customized message for an end user based on the end user having acquired an incomplete message and compensating the end user with, *e.g.*, reward points, for receiving via the Internet and printing a complete and customized message at the end user.

Regarding Goldhaber and Farros, the Examiner alleges that Goldhaber discloses "e-payment technologies and customer accounts" and "online user data gathering technology." The Examiner also alleges that Farros "implicitly discloses a website for user registration" and discloses the "selection of a template [made of ads] by the registered user to make the final product."

Unlike Applicant's claimed invention, both Goldhaber and Farros fail to teach or suggest using the Internet to dynamically generate a customized message for an end user based on the end user having acquired an incomplete message and compensating the end user with, *e.g.*, reward points, for receiving via the Internet and printing a complete and customized message at the end user.

The cited references are each individually complete and functional in itself, so there would be no reason to use parts from or add or substitute parts to any reference. One cannot use hindsight reconstruction to pick and chose among isolated disclosures in the prior art to render the claimed invention. See In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

Stated differently, "[I]t is impermissible to use the claimed invention as an instruction manual or

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"template" to piece together the teachings "of the prior art so that the claimed invention is rendered obvious." *Id.* Applicant therefore submits that the current claims distinguish over the references alone and in combination and are not rendered obvious. Accordingly, withdrawal of the rejections is respectfully requested.

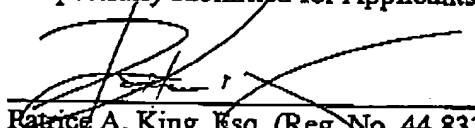
CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the application is in condition for allowance and accordingly, allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place the case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

The Commissioner is authorized to charge any required fees, including any extension and/or excess claim fees, any additional fees, or credit any overpayment to Deposit Account 06-0923. Applicant claims small entity status. See 37 C.F.R. 1.27.

Respectfully submitted for Applicants,



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